

**Restriction** of the generic, linking claims 28 and 29 is improper under applicable law and restriction of the proper Markush claim is likewise improper.

With respect to the imposition of a restriction requirement as to species embraced by the generic and linking claims, Applicants respectfully draw attention to the recent decision by the Federal Circuit Court of Appeals, which notes that an applicant may prosecute generic, linking claims (*i.e.* claims 28 and 29) “without running afoul of the restriction requirement ***because they are linking claims.***” *In re Michael P. Doyle*, 01-1439, \*10 (Fed. Cir., June 12, 2002) (Fed. Cir. BBS) citing MPEP §809.03 (8<sup>th</sup> ed. 2001), emphasis added. Indeed, in the Doyle case, the Solicitor for the PTO agreed with the Court that the applicant ***should*** have prosecuted these claims. The Court held that the absence of such claims from the parent application was an error in the patent correctable under the reissue statute. *Id.* at \*11.

Further, in reaching the decision in the case, the Court noted that allowance of a linking claim prompts the examination of covered species. *Id.* at \*13. The Court states that “The MPEP expressly provides that ‘[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.’” *Id.*, citing MPEP § 809.04, emphasis added by the Court. Yet, in the present case, the restriction requirement imposed upon the claims with respect to a single species of TAO polypeptide for examination attempts to foreclose Applicants’ ability to have their generic and linking claims properly examined. Such an attempt is in direct contradiction to the reliance of the Court on the procedures available to the Applicants as provided in the MPEP and is therefore in error.

Additionally, the Examiner is required to identify generic, linking claims, pursuant to MPEP 809.02(a) and 804.06(d). The instant Requirement is, therefore, improper, because it does not identify the presently pending generic, linking claims, for example claims 28 and 29.

At the most, under MPEP § 809.02(a), Applicants may be required to elect a species for examination under a generic claim. However, Applicants may not be required to amend the claim to remove its generic scope. Applicants have made such a species election above.

Similarly, MPEP § 803.02 provides that “A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. § 103 with respect to the other member(s). In applications containing claims of that nature, the examiner *may require a provisional election of a single species prior to examination on the merits.*” Emphasis added.

Applicants respectfully note that there continues to be no showing that any of the Markush style claims presented are improper. Therefore, requiring restriction, as opposed to provisional election, to a single species of TAO polypeptide of the group is not proper. Applicants respectfully submit that, at the most, Applicants may be required to provisionally elect a single species – a requirement with which the Applicants have complied above.

In view of the above, the additional “restriction requirement” as stated in the Requirement is improper on the facts and under applicable law. Having elected the species of TAO2 polypeptides for the instant case, any issue of any further restriction is now moot in the present case. Applicants respectfully contend that they are entitled to have the generic and Markush claims properly examined in this and any continuation application containing such claims.



Applicants respectfully request favorable consideration of this case in view of the above.

Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3035.

### **REQUEST FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of two months to and including October 30, 2002, in which to respond to the Restriction Requirement dated July 30, 2002.

Pursuant to 37 C.F.R. § 1.17, a check in the amount of \$200.00 is enclosed, which is the process fee for a two-month extension of time.

If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No. 50-1212/UTSD:1276USC1.

Respectfully submitted,

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